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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,594	05/28/1999	GLENN PETKOVSEK	USA-P99-005	8241

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/18/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/322,594

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3722

## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Arguments***

1. In view of the Appeal Brief filed on December 29, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

Art Unit: 3722

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek (5,697,648) in view of Schwan et al (5,524,934).

Petkovsek discloses in Fig. 1, 2 and 6, a mailing assembly and a method for preparing a mailpiece comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms includes a first return postcard (13) integrally formed with a designator section (20, 24A, and 26) indicative of a special service (Col. 4, lines 10-14 and 29-31) having an area consisting of a machine readable code (24 for tracking the mailpiece), an

Art Unit: 3722

identifying number (26A), an area for receiving instructions (20), and being distinctly colored (Col. 4, lines 40-41) and contained within the first exterior sides (right of perforated line 29a, and left of perforated line 33a) that defines the postcard; wherein the first mailing form (10a) is removably attached (60) to the second mailing form (10b); wherein the second mailing form (Fig. 6) has a second return postcard (13b) integrally formed with a second designator section which is contained within the second exterior sides of the second return postcard; a first anchor portion (28) extending outside one of the exterior sides (33a) of the first return postcard, wherein the first anchor portion has adhesive (48) on the backside (Fig. 2), is removably attached to the postcard via a tear line (33) a removable label section (30) attached to the first anchor portion (28) via a tear line (32), a third designator section (36) contained within the first anchor portion, and a second anchor portion (27) removably attached to the return postcard by a tear line (29).

However, Petkovsek does not disclose: a designator section having a color corresponding to one of a plurality of special services, wherein the color is different for each one of the special services.

Schwan et al discloses in Fig. 3, a record in the form of a label assembly (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coating of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible area (Fig. 3). The coatings (color formers and color developers) can be applied in selected areas on the label, and when combined can form blocks of background color(s) (Col. 4, lines 58-61) wherein the label can be used for

Art Unit: 3722

mailing labels in which different colors are activated to designate the method (special services) of shipment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's label to include a label having designated areas, wherein each area has a color corresponding to a shipment method (special services) as taught by Schwan et al for the purpose of providing a means of emphasizing different categories of information on a label assembly.

In regards to **Claims 1, 7, 9 and 13**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, Petkovsek's label is capable of denoting a special service that includes registered mail, certified mail, COD, return receipt for merchandise. Furthermore, in regards to Claim 13, the bar coded area of Petkovsek is capable of receiving instructions regarding the delivery of the mailpiece by a special service, since it would be obvious to program the bar code to receive or transmit any desirable information depending on the intended use of the bar coded area and the desired information to be retrieved.

Art Unit: 3722

In regards to **Claims 13-15**, the method for preparing a mailpiece for delivery by providing a backing sheet (Fig. 1), providing a first and second mailing form having a first and second return postcard integrally formed with a first and second designation section (as seen in Fig. 6), providing an anchor portion adjacent the return postcard (27 and 28 as seen in Fig 2), removing the mailing form from the backing sheet and attaching the form to a mailpiece (seen in Fig. 4), providing a removable label section (30) as a portion of the anchor portion (28, as seen in Fig. 1, and stated in Col. 5, lines 1-6), a providing an area for variable printed information (signature section (marked by an "X") shown in Fig. 5, below section (22)) is taught by Petkovsek.

3. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek in view of Walz (5,664,725).

Petkovsek discloses in Fig. 1, 2 and 6, a mailing assembly and a method for preparing a mailpiece comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms includes a first return postcard (13) integrally formed with a designator section (20, 24A, and 26) indicative of a special service of registered mail, COD, or return receipt (Col. 4, lines 10-14 and 29-31) having an area consisting of a machine readable code (24 for tracking the mailpiece), an identifying number (26A), an area for receiving instructions (20), and contained within the first exterior sides (right of perforated line 29a, and left

Art Unit: 3722

of perforated line 33a) that defines the postcard; a first anchor portion (28) extending outside one of the exterior sides (33a) of the first return postcard, and wherein the first anchor portion has adhesive (48) on the backside (Fig. 2), is removably attached to the postcard via a tear line (33) a removable label section (30) attached to the first anchor portion (28) via a tear line (32); wherein the first mailing form (10a) is removably attached (60) to a second mailing form (10b); wherein the second mailing form (Fig. 6) has a second return postcard (13b), and a second anchor portion (28B) removably attached to the second return postcard wherein the second anchor portion has the adhesive (48) on a backside of the second anchor portion and wherein the second return postcard has no adhesive; and a tear line (33b) arranged for separating the second anchor portion from the second return postcard (13b).

However, Petkovsek does not disclose a first and second backing strip received over the adhesive on the backside of the first and second anchor portion.

Walz discloses in Fig. 1, 4 and 5, an assembly comprising a first form (84) having a first postcard (70), a first anchor portion (58) removably attached to the postcard via a tear line (24), wherein the first anchor portion has adhesive (16) on the backside of the anchor (seen in Fig. 5), a first backing strip (49) received over the adhesive on the anchor portion's backside.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's assembly to include a backing strip received over the adhesive on the anchor portion as taught by Walz as an alternative means to protect the adhesive.



Art Unit: 3722

*Response to Arguments*

4. Applicant's arguments filed on December 29, 2003 have been fully considered but they are not persuasive.

In response to applicant's arguments that the Petkovsek reference does not disclose a designator section having a color corresponding to one of a plurality of special services, wherein the color is different for each one of the special services. The examiner submits that the Petkovsek reference as modified by Schwan et al discloses this limitation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's label to include a label having designated areas, wherein each area has a color corresponding to a shipment method (special services) as taught by Schwan et al for the purpose of providing a means of emphasizing different categories of information on a label assembly.

In response to applicant's argument that the Petkovsek references do not disclose a designator section within the exterior sides that define a postcard wherein the designator section is integrally formed with the return postcard, the examiner submits that Petkovsek discloses a designator section in Fig. 1, and as set forth in the above 103 rejections. Further, since applicant has not defined in detail what "special service" entails in Claim 16, the examiner has interpreted "special service" in its broadest sense. Furthermore, Applicant's arguments regarding "the special designation section" do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art

Art Unit: 3722

disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.


### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 15, 2004



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